

REMARKS/ARGUMENTS

This Amendment is being filed in response to the Final Office Action dated January 22, 2009. Reconsideration and allowance of the application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1, 2, 4-8 and 12-15 are pending in the application. Claims 3 and 9-11 are canceled herein, without prejudice. The Applicants respectfully reserve the right to reintroduce subject matter deleted herein, either at a later time during the prosecution of this application or any continuing applications.

In the Final Office Action, the rejection under 35 U.S.C. §112, first paragraph of claim 5 is not maintained. It is presumed that this rejection is withdrawn. Should this belief be in error, it is respectfully requested that a new Office Action be issued stating that the rejection is maintained and providing the position with regard to the arguments provided by the Applicants so that the Applicants are provided an opportunity to respond to any position taken.

In the Final Office Action, the rejection under 35 U.S.C. §101 of claims 13 and 14 5 is not maintained. It is presumed that this rejection is withdrawn. Should this belief be in error, it is

respectfully requested that a new Office Action be issued stating that the rejection is maintained and providing the position with regard to the arguments provided by the Applicants so that the Applicants are provided an opportunity to respond to any position taken.

In the Final Office Action, it is alleged that the amendment filed on November 5, 2008 with regard to the specification and FIG. 3 introduced new matter into the disclosure. The Final Office Action has taken a position that "[t]here was no previous disclosure that the boot sector is preferably located in a protected storage area ... separate from the storage unit 34, such as in a memory 35 (emphasis added)." This position that the amendment introduced new matter is respectfully traversed.

It is respectfully submitted that the amendment is well supported by the specification as originally filed.

For example, the specification on page 6, lines 29-30 makes clear that "the boot sector is preferably located in a protected storage area, which may be inside the storage unit or separate from the storage unit." This language directly parrots the language added to page 7, line 17 of the specification and as substantially

added to FIG. 3. The only change in the language was the language "such as in a memory 35" which hardly can be said to be new matter.

The specification provides and provided as filed that "the boot sector is preferably located in a protected storage area ..." (See, present application, page 6, lines 29-30.) Is it the position of the Final Office Action that a protected storage area is other than a memory? It is respectfully submitted that a person of ordinary skill in the art would readily appreciate that a storage area is a memory.

Further, the application as filed provides (emphasis added) "[t]his boot sector ... can even be stored in ROM memory." Accordingly, it is clear that the application as filed provided for the boot sector being stored in a memory.

However, in the interest of advancing consideration and allowance of the pending application, the specification is amended to recite that the "boot sector is preferably located in a protected storage area, which may be inside a storage unit 34 or separate from the storage unit 34, such as in a protected storage area 35" wherein the prior term memory is substituted for the term protected storage area. It is hoped that this change addresses any reservations with regard to the position that new matter is

introduced as this language is identical to the language from the specification as filed. Accordingly, consideration and entrance of the amendments to the specification currently, and FIG. 3 previously, is respectfully requested.

Claims 1, 2, 4-8 and 12-15 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Publication No. 2001/0011347 to Narayanaswamy ("Narayanaswamy") in view of U.S. Patent No. 6308,265 to Miller ("Miller"). This rejection is respectfully traversed. It is respectfully submitted that claims 1, 2, 4-8 and 12-15 are allowable over Narayanaswamy in view of Miller for at least the following reasons.

The Final Office Action in a response to arguments section takes a position that (emphasis added) "Narayanaswamy discloses that the system has the capability of overwriting the original boot block with new boot data during the upgrading process." (See, Final Office Action, response to Argument Section, page 4.) It is not clear what this has to do with the claim a presented which does not provide for a term such as "original boot block." It is respectfully submitted that the claims provide for "current boot code" and "new boot code" which has little to do with the teaching of Narayanaswamy which shows a memory system that utilizes two boot

code units 22, 24, one being active and the other being inactive (see, FIG. 2, paragraph [0018]). Narayanaswamy maintains each of the boot code units with one storing an active boot code block and the other storing the inactive boot code block (see, paragraph [0024]). New boot code is written into the boot code unit that is inactive and thereafter, the inactive boot code unit is made the active boot code unit (see, FIG. 4A, paragraph [0027]).

It is believed that regardless of the comments contained in the Final Office Action Response to Arguments section, the Final Office Action understands this distinction regardless of what the Response to Arguments section presents since in the Final Office Action, it is undisputed that "Narayanaswamy, however, does not disclose that the new boot code is downloaded in the section that has the current application code and overwrites the current application code. Nor does Narayanaswamy disclose of writing the new boot code in place of the current boot code in the first location, indicating that the new boot code written in the first location replaces the new boot code written in the second location." (See, Final Office Action, page 8.)

In Miller, prior to writing over an existing boot block, a copy of the boot block from a first region (see, FIG. 2, block 200-

1) is copied to another region (see, FIG. 2, block 200-2). After confirming that the original boot block and the copy are identical, new boot data is written over the original boot block (see, abstract and FIG. 3). FIG. 2 shows a memory in accordance with the teachings of Miller. In FIG. 2, the boot code block is stored in block 200-1 along with an updatable portion of the BIOS that extends from block 200-1 to 200-2 (see, Col. 5, lines 6-18). The original boot block and updatable portion of the BIOS is copied over the updatable portion of the BIOS that extends into the section 200-2 (see, FIG. 3, step 300, and col. 5, lines 52-55). Thereafter, the original boot block is overwritten (erased during step 340 and updated during step 350) with new boot data.

Accordingly, neither of Narayanaswamy nor Miller disclose nor suggest the currently claimed solution as recited in the claims.

Each of these different solutions ensures that a bootable system is available in case of problems with updating the boot code. Narayanaswamy does this by only writing over an inactive code block in the inactive code unit. Miller does this by copying the active boot code block from a first region to a second region, and then writing over the boot code block in the first region.

While the Final Office Action finds many reasons for combining references (see, Final Office Action, pages 4-6), none of these reasons are expressed as the reason for the combination of Narayanaswamy with Miller. While a combination of Narayanaswamy with Miller may yield predictable results, it is respectfully submitted that since neither discloses nor suggests the elements of the claims, where is the motivation for the selective combination to end up with a system that is nether disclosed nor suggested by either alone or in combination.

It is respectfully submitted that for the above rejection, the Final Office Action cites a motivation to make the particular combination of selected portions of references that finds no support in the cited references.

The suggestion in the Final Office Action that the combinations of prior art references "would be obvious to one having ordinary skill in the art ..." is respectfully refuted. One may not utilize the teachings of the present application as a road map to pick and choose amongst prior art references for the purposes of attempting to arrive at the presently disclosed invention.

The stated motivation for combining the references is nowhere

recognized in the prior art and in fact, each of Narayanaswamy and Miller solve the problem stated as motivation albeit in different ways than as recited in the claims and therefore no such motivation exists.

Where a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the missing feature. Al-Site Corp. v. VSI International Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment).

The mere fact that the prior art device could be modified so as to produce the claimed device, which in this case even in combination it does not, is not a basis for an obviousness rejection unless the prior art suggested the desirability of the modification. See, In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984); and In re Laskowski, 871 F.2d 115, 117 (Fed. Cir. 1989).

The only suggestion that can be found anywhere for making these combinations appears to come from the present patent application itself.

How can the Final Office Action espouse that this reconstruction forwarded does not include knowledge gleamed only from the applicant's disclosure? If this reconstruction did not come from the present application, where did it come from? The above reconstruction certainly did not come from the prior art since each of Narayanaswamy and Miller do not disclose or suggest the solution provided by the subject matter recited in the claims.

It is clear that the suggestion to combine references should not come from the Applicants, as was forcefully stated in *Orthopedic Equipment Co. v United States*, 217 U.S.P.Q. 193, 199 (C.A.F.C. 1983): "It is wrong to use the patent in suit [here the application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO]."

The Final Office Action further states that the motivation for combining Narayanaswamy and Miller finds that "[t]he motivation to do so is to will allow a larger amount of memory within the memory device to be allocated for the storage of the updated main firmware." (See, Final Office Action, page 9.) Yet again this

position finds no support in either of Narayanaswamy or Miller. Further, there are innumerable ways to provide for a larger amount of memory, for example, why not simply provide for a larger memory since neither of Narayanaswamy or Miller are limited to a given memory size. It is respectfully submitted that making up some arbitrary motivation to arrive at a solution that is admittedly not shown by either of Narayanaswamy or Miller is not evidence of a proper motivation for altering both of Narayanaswamy and Miller in a way that is not contemplated by either.

It is respectfully submitted that Narayanaswamy in view of Miller does not disclose or suggest, a system that amongst other patentable elements, comprises (illustrative emphasis provided) "a current boot code in a first location, the method comprising the following steps: upon a download request, downloading a new boot code in a second location, which does not overwrite the current boot code and does overwrite a current application code, indicating that the new boot code in the second location replaces the current boot code, writing the new boot code in place of the current boot code in the first location, indicating that the new boot code written in the first location replaces the new boot code written in the second location, downloading a new application code associated

to the new boot code in a location, which does not overwrite the new boot code in the first location, indicating that the new application code is valid" as recited in claim 1, and as substantially recited in claim 2.

Based on the foregoing, the Applicants respectfully submit that independent claims 1 and 2 are patentable over Narayanaswamy in view of Miller and notice to this effect is earnestly solicited. Claims 4-8 and 12-15 respectively depend from one of claims 1 and 2 and accordingly are allowable for at least this reason as well as for the separately patentable elements contained in each of the claims. Accordingly, separate consideration of each of the dependent claims is respectfully requested.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

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